

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/660,324 09/12/00 AHN

K M4065.0127/F

EXAMINER

MMC2/0411  
DICKSTEIN SHAPIRO MORING & OSHINSKY LLP  
2101 L STREET NW  
WASHINGTON DC 20037-1526

TOLEDO, E

ART UNIT

PAPER NUMBER

2823

DATE MAILED:

04/11/01

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/660,324	AHN ET AL.
Examiner	Art Unit	
Fernando Toledo	2823	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 12 September 2000.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 88-123 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 88-123 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved

12)  The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

15)  Notice of References Cited (PTO-892)      18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      19)  Notice of Informal Patent Application (PTO-152)  
17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.      20)  Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 107 – 122 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
2. Claims 107 – 122 provides a method for use in a various circuit devices (i.e. RF communication systems), but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.
3. Claims 107 – 122 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).
4. Claim 122 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear how an active circuit element is formed on the

insulating layer if Applicant forms the passive circuit element on the same insulating layer while bonding an integrated circuit chip to the interposer layer.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 88 – 100, 105 – 118 and 123 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stone (U. S. patent 5,770,476) in view of Forbes (U. S. patent 6,201,287 B1).

In re claim 88, Stone discloses in the U. S. patent 5,770,476; figures 1 – 3 and related text, a process for forming an interposer element 100, including the steps of; providing an insulating layer 7; processing the insulating layer to produce at least one passive circuit element 17 on or within the insulating layer.

Stone does not show wherein the insulating layer is provided on at least one silicon substrate; wherein the passive circuit element is being separated from the silicon substrate by a portion of the insulating layer; and a portion of the insulating layer having a thickness such that the passive circuit element is electrically shielded from the silicon substrate (columns 5 and 6).

However, Forbes in the U. S. patent 6,201,287 B1; figures 1 – 10 and related text, shows forming a passive circuit element 32 in an insulating layer 36 that is on at least one surface of a silicon substrate 100 wherein a portion of the insulating layer has

a thickness such that the passive element is electrically shielded from the substrate (column 4).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the interposer element of Stone with the teachings of Forbes (i.e. shows forming a passive circuit element 32 in an insulating layer 36 that is on at least one surface of a silicon substrate 100 wherein a portion of the insulating layer has a thickness such that the passive element is electrically shielded from the substrate) because the processing steps of Forbes will enable the practitioners of Stone to form an interposer layer within an insulating layer in a silicon substrate.

In re claim 89, Stone teaches bonding an integrated circuit chip 31 to the interposer layer 100 such that the integrated circuit chip is electrically connected to the passive circuit element (figure 2).

In re claim 90, Stone teaches wherein the step of bonding comprises solder bonding 35 (figure 2).

In re claim 91, Stone teaches wherein the step of bonding comprises flip-chip bonding (figure 2).

In re claim 92, Stone teaches that the insulating layer is formed of an oxide (column 5).

In re claim 93, Stone substantially teaches the invention as claimed, but fails to explicitly teach that the oxide is  $\text{SiO}_2$ .

However, silicon dioxide it's a well-known insulating layer that can be readily grown from a silicon substrate. Therefore it would have been obvious to one having

ordinary skill in the art at the time the invention was made to have silicon dioxide as the oxide layer in Stone's invention because it is readily grown and choosing a material for its disclosed intended purposes requires only ordinary skill in the art. Note that the specification contains no disclosure of either the critical nature of the claimed material being of silicon oxide or any unexpected results arising therefrom. Where patentability is said to be based upon particular chosen material or upon another variable recited in a claim, the Applicant must show that the chosen material is critical. *In re Woodruf*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

In re claim 94, Stone substantially teaches the invention as claimed, but fails to show that the insulating layer has a thickness within a range of three to five microns.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the insulating layer of a thickness of three to five microns, since insulating layer thickness are well known processing variable and it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Also, note that the specification contains no disclosure of either the critical nature of the claimed thickness or any unexpected results arising therefrom. Where patentability is said to be based upon particular chosen thickness or upon another variable recited in a claim, the Applicant must show that the chosen thickness are critical. *In re Woodruf*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

In re claim 95, Stone substantially teaches wherein the insulating layer includes polimydes among other suitable materials in the invention as claimed but fails to teaches that the insulating layer is formed of polyamide.

However, polyamides have been known in the art to be attractive materials to use as insulating materials because of their high temperature tolerance, they are free of pinholes and cracks, among other advantages.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a polyamide film as an insulating layer because it offers high temperature tolerance and are free of pinholes and cracks among other advantages. Note also that the specification contains no disclosure of either the critical nature of the claimed material being of polymide or any unexpected results arising therefrom. Where patentability is said to be based upon particular chosen material or upon another variable recited in a claim, the Applicant must show that the chosen material is critical. *In re Woodruf*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). Also, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a polymide as an insulating material, since it has been held to be within the general skill of a worker in the art to select a known material on the base of its suitability, for its intended use involves only ordinary skill in the art. *In re Leshin*, 125 USPQ 416.

In re claim 96, Stone teaches the step of forming a pattern on or within the insulating layer, the metallization pattern 21 connected with the passive circuit element 17 (figure 1).

In re claim 97, Stone teaches wherein the step of processing the insulating layer further comprises the step of producing several passive circuit elements on or within the insulating layer (column 6).

In re claim 98, Stone teaches that the passive circuit element is a resistor element (column 6).

In re claim 99, Stone teaches that the resistor is a thin film resistor (column 6).

In re claim 100, Stone teaches that the passive circuit element includes a capacitor element (column 6).

In re claim 105, Stone teaches that the passive circuit element includes an inductor element (column 6).

In re claim 106, Stone does not explicitly show that the inductor element is a spiral inductor.

However, Forbes teaches forming an inductor in a spiral conformation (figure 10).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the inductor of Forbes in Stone's invention because the practitioners of Stone can form the inductor with Forbes' teaching. The selection of a known inductor pattern on the basis of its suitability for its disclose intended purposes requires only ordinary skill in the art.

In re claim 107, Stone substantially teaches the claimed invention, but fails to show fabricating the passive circuit device for use in RF communication systems.

Since, Stone does form passive electrical devices, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to use

Stone's invention in an RF communications system since it hold similar elements to that the Applicant is claiming.

Note also that Forbes teaches that the invention relates to RF communication systems (column 1).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to form an RF communication system out of Stone's invention since it is well known in the art that FR communication system have the same elements as those on Stone's invention.

In re claim 108, Stone does not explicitly teach forming a circuitry to use in RF communication systems.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use Stone's invention for RF communication system since the invention is to be used for devices that uses interposers with at least one passive circuit element (column 1).

In re claims 109 and 110, Stone substantially discloses the claimed invention but fails to show wherein at least one passive device is for use in an amplifier (e.g. load or broad band).

Note that Forbes teaches that inductors (passive circuit elements) are well known in the art and used as amplifiers (column 2).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to use one of the passive devices in Stone's invention since it is well known in the art to use inductors as amplifiers.

In re claims 111 and 112, Stone substantially discloses the claimed invention but fails to show that wherein at least one passive circuit device is for use in an oscillator (e.g. control voltage oscillator).

Note that Forbes teaches that inductors (passive circuit elements) are well known in the art and used as oscillators (column 2).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to use Stone's invention wherein at least one of the passive circuit device is used as an oscillator since it is well known that passive circuit device are used for that purpose.

In re claims 113 – 116, Stone discloses that the integrated circuit chip 31 are electronic devices.

Stone does not show that the electronic devices are analog circuitry, digital circuitry, microprocessor, memory chip.

However it is well known to someone having ordinary skill in art, that an electronic device comprises analog circuitry, digital circuitry, microprocessor, memory chip, etc. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the electronic devices of Stone as analog circuitry, digital circuitry, microprocessor and memory chip since analog circuitry, digital circuitry, microprocessor and memory chip are well known in the art. The selection of a known electronic device on the basis of its suitability for the disclosed intended purposes requires only ordinary skill in the art.

In re claim 117, Stone discloses the step of forming a bonding layer, the bonding layer located in the area between the integrated circuit chip and the insulating layer (column 8).

In re claim 118, Stone discloses that the bonding agent is a conductive adhesive among other suitable material (column 8).

Stone does not show that is an epoxy.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the conductive adhesive out of epoxy since it has been well known in the art that conductive adhesives are conventionally made out of epoxies.

In re claim 123, Stone discloses providing at least one passive circuit element in each area of the insulating layer, dividing the substrate into areas and bonding at least one integrated circuit chip to each of the areas of the insulating layer to from respective chip carriers (column 1).

6. Claims 101 – 104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stone and Forbes as applied to claims 89 - 100 above, and further in view of Farooq et al. (U. S. patent 5,912,044).

In re claim 101, Stone in view of Forbes does not teach that the capacitor is a thin film capacitor.

However, Farooq in the U. S. patent 5,912,044; figures 1 – 8 and related text, discloses a method of forming a thin film capacitor that are to be used typically in

interposer layers because the signal propagation characteristics of interposer layers can be further enhanced by placing thin film capacitors (column 1).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to form a thin film capacitor as taught by Farooq as the capacitor taught by Stone because it will enable the practitioners of Stone to form the capacitor and by forming a thin film capacitor they will enhance the signal propagation of the device.

In re claim 102, Stone in view of Forbes does not teach that the thin film capacitor includes a dielectric layer.

However, Farooq teaches that the thin film capacitor includes a dielectric layer 16 (column 3).

In re claim 103, Stone in view of Forbes does not teach that the dielectric layer of the capacitor is an oxide.

However, Farooq teaches that the dielectric 16 can be made of oxides (column 4).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the dielectric film out of an oxide, since it has been held to be within the general skill of a worker in the art to select a known material on the base of its suitability, for its intended use involves only ordinary skill in the art. *In re Leshin*, 125 USPQ 416.

In re claim 104, Stone in view of Forbes does not teach that the dielectric film can be formed of oxide-nitride-oxide films.

However, Farooq teaches that the dielectric 16 of the thin-film capacitor can be made of oxide-nitride-oxide films (column 4).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the dielectric film out of an oxide-nitride-oxide film, since it has been held to be within the general skill of a worker in the art to select a known material on the base of its suitability, for its intended use involves only ordinary skill in the art. *In re Leshin*, 125 USPQ 416.

7. Claims 119 – 121 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stone and Forbes as applied to claims 88 – 100 and 105 - 118 above, and further in view of Solberg (U. S. patent 6,121,676).

In re claim 119, Stone shows forming a package out of the interposer element and at least one integrated circuit.

Stone in view of Forbes does not teach encapsulating the interposer element and the integrated circuit and having conducting leads on an outer side of the package.

However, Solberg in the U. S. patent 6,121,676; figures 1 – 19 and related text discloses a method of encapsulating an interposer element with at least one integrated circuit (column 8), the package having conducting leads on an outer side of the package to connect to a circuit board.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to encapsulate the package of Stone in view of Forbes as taught by Solberg because the teachings of Solberg will enable the practitioners of Stone in view

of Forbes to form the package as taught by Solberg and therefore realize the function of the device by connecting it to a circuit board.

In re claim 120, Stone in view of Forbes do not explicitly show providing conductive leads connecting the interposer element and at least one integrated circuit to the conductive package leads of the circuit package.

However, Solberg teaches forming conductive leads 22 to the package in order to connect the circuit package to a circuit board.

In re claim 121, Stone shows providing an insulating layer to both surfaces of the substrate (figure 1).

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fernando Toledo whose telephone number is (703) 305-0567. The examiner can normally be reached on Monday – Friday, 8am – 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy can be reached on (703) 308-4918. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications.

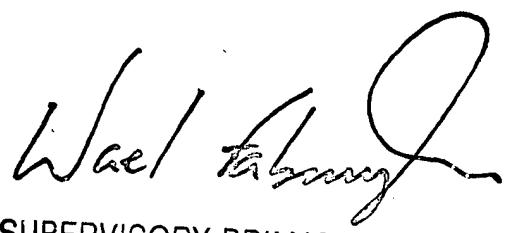
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Application/Control Number: 09/660,324  
Art Unit: 2823

Page 14

Fernando Toledo  
Patent Examiner  
Art Unit 2823

ft  
March 29, 2001



SUPERVISORY PRIMARY EXAMINER  
TECHNOLOGY CENTER 2800